REMARKS

Upon entry of this amendment, claims 12 and 15-19 are pending. By the present amendment, claim 19 has been added. Favorable reconsideration of the application is respectfully requested.

The rejection of claims 12 and 15 under 35 U.S.C. §103(a) over Martin et al. (U.S. Patent No. 5,848,398, hereinafter "Martin") in view of Johnny Rockets Name That Tune (hereinafter "Johnny Rockets") is respectfully traversed. At the outset, Applicant respectfully maintains the position that a prima facie showing of the date to which the reference to Johnny Rockets is entitled has not been adequately established. Therefore, the following remarks are made without acquiescing in the characterization in the Office Action of the relevant date of Johnny Rockets.

Martin is directed to a system for managing a plurality of computer jukeboxes. In general, Martin discloses a method and apparatus for managing a plurality of comptuer jukeboxes at different locations from a central station. Each jukebox includes processor means for controlling the computer jukebox, storage and retrieval means for data, display means for selection menus, audio production means for playing musical records and a user interface enabling patrons to communicate with the processor means. The central station may be used to download musical recording data to each computer jukebox, and each computer jukebox can upload usage data to the central station.

Contrary to the unfounded allegation set forth in the Office Action, there is no teaching or suggestion in Martin of the computer jukebox being operable as a game. Martin merely discloses an electronic jukebox that has the ability to play songs stored thereon, and to update its song library from a central station. The suggestion in the Office Action that Martin somehow teaches using the computer jukebox disclosed therein as a game is without basis. Moreover, there is absolutely no motivation whatsoever in Martin to modify the computer jukebox thereof with any features of a game as suggested in the Office Action. Martin is primarily concerned with the ability to quickly and easily update selections in a jukebox and to provide a means for doing so.

Johnny Rockets, on the other hand, appears to be directed to an electronic version of the popular television "Name that Tune" game. As pointed out in the prior response, there is no teaching or suggestion whatsoever in Johnny Rockets of providing a jukebox system that includes a storage device that stores a library of musical recordings that can be played in full on the terminal for a fee, and further wherein the library of musical recordings can be updated with additional musical recordings through communication with a server, thereby defining a customized library of musical recordings on the jukebox system. Claim 12 further requires that the jukebox system is operable to dynamically select the musical recording for the game from the customized library of musical recordings and to dynamically generate the question for the game based on contents of the customized library of musical recordings stored on the jukebox system.

Internet music games, such as Johnny Rockets Name That Tune, do not include or suggest the particular combination of features set forth in amended claim 12. For example, in Internet games, the music used for the game is not dynamically generated based on a customized library of musical recordings stored on a jukebox system. Moreover, in Internet games, the questions are not dynamically generated based on the contents of the customized library of musical recordings. In addition, in internet games, there is not a jukebox system as claimed that enables a user to select a song for full playback on the jukebox system for a fee.

Johnny Rockets is thus clearly different from the computer jukebox system of Martin. There is no motivation whatsoever, in either Martin or Johnny Rockets of modifying either of the systems to arrive at the claimed invention. Even if the combination were proper (which Applicant respectfully submits is not the case), the combination nevertheless fails to render the claimed invention obvious. For example, the proposed combination fails to teach or suggest that the music for the game is dynamically generated based on a customized library of musical recordings stored on a jukebox system or that the questions are dynamically generated *based on the contents* of the customized library of musical recordings.

It is axiomatic that the PTO has the burden under 35 U.S.C. §103(a) of establishing a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of

ordinary skill in the art would lead that individual to combine the relevant teachings of the references. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). This it has not done. In particular, the Office Action fails to cite prior art that remedies the deficiencies of the references as noted above, or that suggest the obviousness of modifying the references to achieve the claimed invention.

Instead, the Office Action improperly relies on hindsight reconstruction of the claimed invention in reaching is obviousness conclusion. "To imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." See *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1543, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

For at least these reasons, it is respectfully submitted that even if, *arguendo*, the combination of Martin and Johnny Rockets were proper, the combination nevertheless fails to render the claimed invention obvious. Neither of the references, either singly or in combination disclose, teach or suggest the specifically claimed features of the claimed invention. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

The rejection of claims 16-18 under 35 U.S.C. §103(a) over Johnny Rockets in view of Tom & Liz's Name That Tune (hereinafter "Tom and Liz") is respectfully traversed. It is respectfully submitted that Tom and Liz fail to overcome the fundamental

deficiencies of Johnny Rockets noted above and in the prior response. Therefore, even if, arguendo, the combination of Johnny Rockets and Tom and Liz were proper, the combination nevertheless fails to render the claimed invention obvious. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing, it is respectfully submitted that the entire application is in condition for allowance. Favorable reconsideration of the application and prompt allowance of the claims are earnestly solicited.

Should the Examiner deem that further issues require resolution prior to allowance, the Examiner is invited to contact the undersigned attorney of record at the telephone number set forth below.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____
Updeep S. Gill
Reg. No. 37,334

USG:jls
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100